

REMARKS

New Claims 48 - 84 are added herein and the Preliminary Amendment portion of this paper is accompanied by a Request for Continued Examination. Claims 40-43 are amended herein. Claims 1-38 and 44-45 are canceled herein. Claims 39-43 and 46-84 are pending. The Commissioner is authorized to charge the Applicants' account, Deposit Account No. 05-1328, for any fees required by the addition of the new claims or this response.

The following remarks are offered in response to the Third Official Action dated November 18, 2003. Reconsideration and reexamination of this application is respectfully requested. Claims 40-43 are amended to change their respective dependency. In addition new Claims 48 - 84 are added to claim additional embodiments of the invention described in the specification. New Claims 48 - 84 are not added to overcome the rejections contained in the Third Office Action or to comply with any statutory requirement for patentability, but only to claim certain embodiments of the invention which are described in the specification. The support for new Claims 48 through 61 can be found in original Claims 2-9, 13-17, 19-26 and 30-34. The support for new Claims 62 through 84 is found on Page 4, Paragraph 15, second sentence, Page 8, Paragraph 25, in Figures 4, 6, 7 and in original Claims 1-17 and 18-34.

In the Office Action, the Examiner made the following rejections:

Claims 1-3, 7-10, 13, 14, 18-20, 24-27, 30, 31, 35-42 and 44-47 were rejected under 35 U.S.C §102 as being anticipated by U.S. 5,758,990 to Davies et al. ("Davies");

Claims 3 and 20 were rejected under 35 U.S.C §103 as being obvious over Davies in view of U.S. 4,477,207 to Johnson ("Johnson");

Claims 11, 12, 28, 29 and 43 were rejected under 35 U.S.C §103 as being obvious over Davies in view of U.S. 5,477,392 to Marshall ("Marshall");

Claims 15-17 and 32-34 were rejected under 35 U.S.C §103 as being obvious over Davies in view of U.S. 4,422,801 to Hale et al. ("Hale").

Additionally, Claims 4-6 and 21-23 were indicated as containing allowable subject matter but were objected to because they depend from rejected base claims. The Applicants gratefully acknowledge the allowable subject matter.

Previously presented Claim 39 is not taught or suggested by Davies as Davies does not teach or suggest a buoyancy apparatus which includes a frame including a plurality of vertical members externally disposed to a buoyancy element where at least one of the plurality of vertical members extends the vertical length of the buoyancy element.

The Examiner asserts that the Applicants' Claim 39 is anticipated by Davies. The Third Office Action states, among other things, that Davies "discloses... at least one buoyancy element/buoyancy can (16) [and] a frame (24) comprising a plurality of vertical tubular members (14)". However, the Third Office Action is silent concerning Davies disclosing a frame member that extends the length of a buoyancy element. Indeed, in the Second Office Action, dated June 16, 2003, Claim 39, as well as dependent Claims 40 through 43, were all indicated as allowable subject matter even after Davies had been cited in the First Office Action, dated January 6, 2003. Applicant submits that Davies fails to teach or suggest, either in the text or the figures, a frame member which extends the length of any buoyancy element.

Moreover, Davies indicates that its frame or yoke 13 must be shorter than its parallel air cans 16, because Davies makes provision for guide frames 54, which are spaced along the length of the offshore structure and contain guide sleeves 56 which slidably receive the air cans 16.

Davies states:

Since the variable buoyancy air cans 16 may be of a substantial length, one hundred feet or more, *one or more guide frames 54, seen in FIG. 6, may be provided and spaced apart at suitable distances along the length of the offshore structure. The guide frame 54 is provided with suitably sized guide sleeves 56 to slidably receive the stem 12 and air cans 16.*

See column 3, lines 36-42. Notice that the guide sleeves 56 receive the air cans 16 alone and do not receive the sleeves 14 of Davies frame or yoke 13, which would have to be the case if Davies frame or yoke sleeves 14 extended the length of the air cans. Therefore, Davies fails to teach or suggest a frame member/sleeve that extends the length of a buoyancy element and actually teaches away from such an arrangement by including provisions for guide frames that contain the air cans, that are spaced along the length of the riser and that do not overlap with the yoke/frame.

None of the other five references cited in the First Office Action were cited as making any of the existing independent claims unpatentable, but only as making some of the application's dependent claims obvious. Therefore the Applicants do not believe it necessary to address the dependent claim rejections to previously presented and pending Claims 40-43 and

46-47 based on any references other than Davies after establishing the patentability of independent Claim 39 over Davies.

Therefore the Applicants' invention as claimed in Claim 39, and the claims that depend therefrom, including new claims 48-61 are novel and non-obvious in view of Davies and the other references cited in the Third Office Action.

In the Third Office Action the Examiner states that in considering the patentability of the claims under 35 U.S.C. 103(a), the Examiner has presumed that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Out of an abundance of caution the Applicants wish for the Examiner to treat all the claims of the application as not commonly owned for the purposes of examination, including for the purpose of considering potential prior art under 35 U.S.C. 102(f) or (g).

The application is believed to be in condition for allowance. Applicants believe that the prior art does not teach or suggest, either alone or in combination, all the elements of independent Claims 39 and 62. The dependent claims are also believed patentable since they depend on independent Claims 39 and 62. Applicants therefore respectfully request that this application be allowed and passed to issue.

If the Examiner wishes to discuss this application with counsel, please contact the undersigned.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted via facsimile to Examiner Jong-Suk Lee, Technology Center 3600, United States Patent and Trademark Office at (703) 872-9306 on February 17, 2004.


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